REMARKS

At the time of the Office Action dated October 21, 2004, claims 11-14 and 26-31 were pending. In this Amendment, claims 26 and 31 have been amended. Care has been exercised to avoid the introduction of new matter. Specifically, claim 26 has been amended to correct a typographic oversight, and claim 31 has been amended based on claim 26.

Specification.

Correction of the abstract and submission of a new title of the invention have been requested by the Examiner. In response, Applicants have amended the abstract and title, as attached, thereby overcoming the stated bases for the objection to the specification. Accordingly, withdrawal of this objection is respectfully solicited.

Claims 11-14 and 26-31 have been rejected under 35 U.S.C. §102(e) as being anticipated by Imaizumi et al. (U.S. Patent No. 6,215,512) ("'512 patent").

In the statement of the rejection, the Examiner asserted that the '512 patent discloses an image forming apparatus identically corresponding to what is claimed. This rejection is respectfully traversed.

The '512 patent has an effective filing date of June 10, 1999 for the purposes of being utilized as prior art against pending US patent applications. However, the instant application has a priority date of July 3, 1998, based on the claim of priority to Japanese patent applications Nos. 10-188724, 10-188730 and 10-188736. A certified translation of the priority document (10-188730), which is relevant to this application, has been submitted with this Amendment in order to perfect the claim of priority. Thus, the '512 patent does not constitute prior art to the instant application.

Applicants, therefore, respectfully solicited withdrawal of the rejection 11-14 and 26-31 under 35 U.S.C. §102(e) and favorable consideration thereof.

Claims 11-14 and 26-31 have been rejected under 35 U.S.C. §102(e) as being anticipated by Imaizumi et al. (U.S. Patent No. 6,441,915) ("'915 patent").

In the statement of the rejection, the Examiner asserted that the '915 patent discloses an image forming apparatus information identically corresponding to what is claimed. This rejection is respectfully traversed.

Similar to the '512 patent, the '915 patent has an effective filing date of June 10, 1999 for the purposes of being utilized as prior art against pending US patent applications. Therefore, submission of the certified translations of the priority documents disqualifies the '915 patent for the prior art of the instant application.

Applicants, therefore, respectfully solicited withdrawal of the rejection 11-14 and 26-31 under 35 U.S.C. §102(e) and favorable consideration thereof.

Claims 11-14 and 26-31 have been rejected under 35 U.S.C. §102(f) because, according to the Examiner, one of Applicants did not invent the claimed subject matter.

In the statement of the rejection, the Examiner recognized that the invention entity (Imaizumi, Hirota, Sugiura) invents both the '512 and '915 patents that have the same drawings and the same section of "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS" as those disclosed in the present applications. Then, the Examiner concluded that Imaizumi, Hirota and Sugiura as a team made the present invention, but Tsuboi who is listed as an inventor in this

application did not have any contribution and is not an inventor. This rejection is respectfully traversed.

In response, Mr. Tsuboi will be removed from co-inventors of invention claimed herein to obviate the rejection. Necessary documents to remove Mr. Tsuboi have been forwarded to Applicants for execution, and will be submitted upon receipt.

Claim 31 has been rejected under 35 U.S.C. §102(b) as being anticipated by Kanai et al.

In the statement of the rejection, the Examiner asserted that Kanai et al. discloses an image forming apparatus identically corresponding to what is claimed.

It is well established precedent that the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

In response, Applicants have amended claim 31 so that the claimed image forming apparatus includes "a controller which sets the image distortion to a predetermined value when the image distortion detected by said sensor exceeds the predetermined range and controls said corrector to correct the image data according to the predetermined value." Based on this amendment, it is submitted that Kanai et al. does not identically describes an image forming apparatus including all the limitations recited in claim 31 within the meaning 35 U.S.C. §102. Applicants, therefore,

respectfully solicit withdrawal of the rejection of claim 31 under 35 U.S.C. §102(b) and favorable consideration thereof.

Claims 11-14, 26, 27, and 29-31 have been rejected under 35 U.S.C. §102(b) as being anticipated by Fukushima.

In the statement of the rejection, the Examiner asserted that Fukushima discloses an image forming apparatus identically corresponding to what is claimed. This rejection is respectfully traversed.

Applicants submit that Fukushima does not disclose an image forming apparatus including all the limitations recited in independent claims 11, 26 and 31. *See Helifix Ltd.*, 208 F. 3d 1339; *Electro Medical Systems S.A.*, 34 F.3d 1048. Specifically, the reference does not disclose detecting image distortion, correcting an image based on the image distortion detected, setting the image distortion to a maximum (or a predetermined value) in a predetermined range for correction of the image when the image distortion detected exceeds the predetermined range, as recited in those claims.

Fukushima discloses correcting and controlling density and gradation of an image detected. Fukushima specifically states, "a test pattern is formed on the photosensitive drum 121, the density of the formed image is detected by an image-density sensor 701 provided so as to face the photosensitive drum 121, and the concentration of the developer 44 is controlled based on the detected density (an image-density detection control method)" (columnn10, lines 17-22 cited by the Examiner).

Based on the above description, Applicants submit that Fukushima does <u>not</u> disclose detecting <u>image distortion</u>, <u>but</u> detecting <u>image density</u>. The Examiner further asserted that ΔD

indicates the "distortion" by citing, for example, column 10, lines 11-30 of the reference. However, the Examiner failed to show that ΔD indicates "image distortion" as recited in the claims. In fact, Fukushima mentions that ΔD is an amount of a shift from initial toner-concentration (see column 11, lines 15-16). Applicants stress that persons skilled in the art would appreciate differences between image distortion and toner concentration in the context of the claims and Fukushima.

Accordingly, it is submitted that the reference does not disclose detecting image distortion, correcting an image based on the image distortion detected, setting the image distortion to a maximum (or a predetermined value) in a predetermined range for correction of the image when the image distortion detected exceeds the predetermined range, as recited in those claims.

It is noted that a dependent claim is not anticipated if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claim. Therefore, claims 12-14, 27, 29 and 30 are patentable because they respectively include all the limitations of independent claims 11 and 26. The Examiner's additional comments with respect to those dependent claims do not cure the argued fundamental deficiencies of Fukushima.

Applicants, therefore, respectfully solicit withdrawal of the rejection of claims 11-14, 26, 27, and 29-31 under 35 U.S.C. §102(b) and favorable consideration thereof.

In paragraph 9, the Examiner stated that the prior art excluding the '512 and '915 patents does not teach claim 28. If so, Applicants submit that claims 12, 13 and 29 should not be rejected based on Fukushima because claim 12 includes a recitation similar to that of claim 28, claim 13 depends on claim 12, and claim 29 depends on claim 28. Applicants respectfully request the Examiner to reconsider claims 12, 13 and 28.

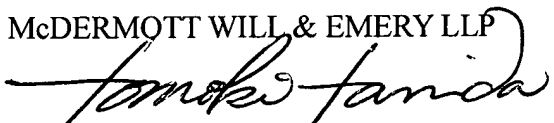
Conclusion.

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Tomoki Tanida
Recognition under 37 C.F.R. 10.9(b)

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 EJW:TT
Facsimile: 202.756.8087
Date: February 22, 2005

Please recognize our Customer No. 20277 as our correspondence address.

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